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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,565	06/19/2000	Colin Allmark	24124	3814

7590 07/23/2003

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EXAMINER

HU, JINSONG

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 07/23/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/596,565

Applicant(s)

ALLMARK, COLIN

Examiner

Jinsong Hu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-13 are presenting for examination.
2. The abstract of the disclosure is objected because it is too long.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/596,374 (hereinafter as '374). Although the conflicting claims are not identical, they are not patentably distinct from each other because both computer systems comprise substantially the same elements. The difference between the application '374 and this application is the compact disc card and the compact disc. It would have been obvious to a person of ordinary skill in the art that the compact disc of this application is indeed the compact disc card of the application '374. Therefore, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Sanford (US 6,536,039).

7. As per claims 1 and 5, Sanford teaches the invention as claimed including a system for updating a compact disc [col. 2, lines 7-11], the apparatus comprising:

a first computer having software stored thereon defining a server [col. 5, lines 17-19], the server having first compact disc updating means associated therewith for storing compact disc update data [col. 2, lines 34-37];

a communications network in communication with the server [col. 5, lines 15-19];

a plurality of remote computers in communication with the server through the communications network, each of the plurality of remote computers having a processor for processing digital data [202, Fig. 2], a memory [204, Fig. 2] in communication with the processor for storing digital data, a user display [212, Fig. 2] in communication with the processor for displaying data to a user, and a compact disc drive [208, Fig. 2] positioned to receive at least one compact disc therein [col. 5, lines 7-19]; and

a compact disc positioned in the compact disc drive of at least one of the remote computers and capable of storing digital data thereon [col. 5, lines 20-29], the compact disc including a seating ring interface seat associated with the compact disc, second card updating means stored on the compact disc and responsive to the first compact disc updating means for updating digital data stored on compact disc with updated data

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created by storing the updated data in the memory of the at least one remote computer [col. 3, lines 6-12; col. 3, line 58 – col. 4, line 8].

8. As per claim 2, Sanford teaches that the graphical user interfacing means includes interface displaying means for displaying a graphical user interface on the user display [col. 3, lines 53-54] and user directing means for directing a user through a plurality of blocks for updating the stored digital data in the memory of the at least one remote computer so that the update appears to the user to be on the card [col. 3, lines 6-12; col. 3, line 58 – col. 4, line 8].

9. As per claim 3, Sanford teaches that the directing means includes software loading means displayed to a user for loading the second card updating means into the memory of the at least one remote computer responsive to the user [col. 4, line 62 – col. 5, line 6].

10. As per claim 4, Sanford teaches that the graphical user interfacing means further includes updating initiating means associated with the second card updating means for initiating the updating of the updated data from the first card updating means [col. 4, lines 37-42].

11. As per claims 6 and 10, Sanford teaches the invention as claimed including a system for updating a compact disc [col. 2, lines 7-11], the apparatus comprising:

a computer having software stored thereon defining a server [col. 5, lines 17-19], the server having first compact disc updating means associated therewith for storing compact disc update data [col. 2, lines 34-37];

a communications network in communication with the server [col. 5, lines 15-19];

a plurality of remote computers in communication with the server through the communications network, each of the plurality of remote computers having a processor for processing digital data [202, Fig. 2], a memory [204, Fig. 2] in communication with the processor for storing digital data, a user display [212, Fig. 2] in communication with the processor for displaying data to a user, and a compact disc drive [208, Fig. 2] positioned to receive at least one compact disc therein [col. 5, lines 7-19]; and

a compact disc positioned in the compact disc drive of at least one of the remote computers and capable of storing digital data thereon [col. 5, lines 20-29], the compact disc including a seating ring interface seat associated with the compact disc, second card updating means stored on the compact disc and responsive to the first compact disc updating means for updating digital data stored on compact disc with updated data created by storing the updated data in the memory of the at least one remote computer [col. 3, lines 6-12; col. 3, line 58 – col. 4, line 8].

12. As per claim 7, Sanford teaches that the graphical user interfacing means includes interface displaying means for displaying a graphical user interface on the user display [col. 3, lines 53-54] and user directing means for directing a user through a

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plurality of blocks for updating the stored digital data in the memory of the at least one remote computer so that the update appears to the user to be on the card [col. 3, lines 6-12; col. 3, line 58 – col. 4, line 8].

13. As per claim 8, Sanford teaches that the directing means includes software loading means displayed to a user for loading the second card updating means into the memory of the at least one remote computer responsive to the user [col. 4, line 62 – col. 5, line 6].

14. As per claim 9, Sanford teaches that the graphical user interfacing means further includes updating initiating means associated with the second card updating means for initiating the updating of the updated data from the first card updating means [col. 4, lines 37-42].

15. As per claim 11, Sanford teaches the invention as claimed including a graphical user interface for updating a compact disc and for enhancing update capabilities to a user of the compact disc, the graphical user interface comprising:

directing means for directing a user through a plurality of blocks for updating stored digital data in memory of at least one remote computer so that the update appears to the user to be on a compact disc, the directing means including software loading means displayed to a user for loading card updating software into the memory

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of the at least one remote computer responsive to the user [col. 3, lines 6-12; col. 3, line 58 – col. 4, line 8]; and

update initiating means associated with the card updating software for initiating the updating of the updated data from remote card updating software [col. 4, lines 37-42; col. 7, lines 5-8].

16. As per claims 12 and 13, since they are method claims of 1-4, they are rejected for the same basis as claims 1-4.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1, 5-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over iOra SoftCD (hereinafter as SoftCD), page 1-3, from iOra Inc., February, 2000, in view of Van Ryzin et al. (US 6,446,080 B1).

19. SoftCD is a prior art reference cited by the applicant on form 1449, filed on 4/9/01.

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20. As per claims 1 and 5, SoftCD teaches the invention substantially as claimed including a system for updating a compact disc [p. 1, paragraph 1], the apparatus comprising:

a first computer having software stored thereon defining a server ["SoftCD Publisher", Figure on p. 2], the server having first compact disc updating means associated therewith for storing compact disc update data [paragraph for "SoftCD – How it works"];

a communications network in communication with the server [Internet, p. 1, paragraph 1];

a plurality of remote computers in communication with the server through the communications network, each of the plurality of remote computers having a processor for processing digital data, a memory in communication with the processor for storing digital data, a user display in communication with the processor for displaying data to a user, and a compact disc drive positioned to receive at least one compact disc therein ["SoftCD Client", Figure on p. 2; paragraph for "iOra Client" on p. 2]; and

a compact disc positioned in the compact disc drive of at least one of the remote computers and capable of storing digital data thereon, the compact disc including a seating ring interface seat associated with the compact disc ["SoftCD client", Figure on p. 2], second card updating means stored on the compact disc and responsive to the first compact disc updating means for updating digital data stored on compact disc with updated data created by storing the updated data in the memory of the at least one remote computer [paragraph for "SoftCD Publisher" on p. 2].

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21. SoftCD does not specifically teach a graphical user interfacing means stored on the compact disc for producing a graphical user interface to enhance update capabilities to a user of the compact disc.

22. However, Van Ryzin on the other hand teaches a graphical user interfacing means stored on the compact disc for producing a graphical user interface to enhance update capabilities to a user of the compact disc [Fig. 2]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of SoftCD and Van Ryzin because using Van Ryzin's user interface in SoftCD's system would improve the flexibility of the system by allowing user to determine how to update the compact disc instead of simply pushing the updated data to user by the server. One of ordinary skill in the art would have been motivated to modify SoftCD's system with Van Ryzin's user interface to improve the integrity of the system.

23. As per claim 6 and 10, SoftCD teaches the invention substantially as claimed including a system for updating a compact disc [p. 1, paragraph 1], the apparatus comprising:

a computer having software stored thereon defining a server ["SoftCD Publisher", Figure on p. 2], the server having first compact disc updating means associated therewith for storing compact disc update data [paragraph for "SoftCD – How it works"];

a communications network in communication with the server [Internet, p. 1, paragraph 1];

a plurality of remote computers in communication with the server through the communications network, each of the plurality of remote computers having a processor for processing digital data, a memory in communication with the processor for storing digital data, a user display in communication with the processor for displaying data to a user, and a compact disc drive positioned to receive at least one compact disc therein ["SoftCD Client", Figure on p. 2; paragraph for "iOra Client" on p. 2]; and

a compact disc positioned in the compact disc drive of at least one of the remote computers and capable of storing digital data thereon, the compact disc including a seating ring interface seat associated with the compact disc ["SoftCD client", Figure on p. 2], second card updating means stored on the compact disc and responsive to the first compact disc updating means for updating digital data stored on compact disc with updated data created by storing the updated data in the memory of the at least one remote computer [paragraph for "SoftCD Publisher" on p. 2].

24. SoftCD does not specifically teach a graphical user interfacing means stored on the compact disc for producing a graphical user interface to enhance update capabilities to a user of the compact disc.

25. However, Van Ryzin on the other hand teaches a graphical user interfacing means stored on the compact disc for producing a graphical user interface to enhance

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update capabilities to a user of the compact disc [Fig. 2]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of SoftCD and Van Ryzin because using Van Ryzin's user interface in SoftCD's system would improve the flexibility of the system by allowing user to determine how to update the compact disc instead of simply pushing the updated data to user by the server. One of ordinary skill in the art would have been motivated to modify SoftCD's system with Van Ryzin's user interface to improve the integrity of the system.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Collins (EP 0994425 A2) discloses a CD updating system; and

Toh et al. (US 6,128,652) discloses a data updating system.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (703) 306 – 5932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678. The fax number for this Group is (703) 308-9052. Additionally, the fax numbers for Group 2100 are as follow:

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Official Faxes: (703) 746-7239

After Final Responses: (703) 746-7238

Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 305-3900.

Jinsong Hu

July 17, 2003


ZARNI MAUNG
PRIMARY EXAMINER